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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/974,710	10/09/2001	Peggy-Jean P. Flanigan	55526US002	7863

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EXAMINER

CHEVALIER, ALICIA ANN

ART UNIT	PAPER NUMBER
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1794

NOTIFICATION DATE	DELIVERY MODE
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01/07/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

LegalUSDocketing@mmm.com
LegalDocketing@mmm.com

Office Action Summary

Application No.

09/974,710

Applicant(s)

FLANIGAN ET AL.

Examiner

Alicia Chevalier

Art Unit

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 19 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-8,10-17,19-22,26,28-53 and 55-60 is/are pending in the application.
- 4a) Of the above claim(s) 36-53 and 55 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-8,10-17,19-22,26,28-35 and 56-60 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

RESPONSE TO AMENDMENT

Request for Continued Examination

1. The Request for Continued Examination (RCE) under 37 CFR 1.53 (d) filed on September 5, 2007 is acceptable and a RCE has been established. An action on the RCE follows.
2. Claims 1, 3-8, 10-17, 19-22, 26, 28-53 and 55-60 are pending in the application, claims 36-53 and 55 are withdrawn from consideration. Claims 2, 9, 18, 23-25, 27, 54 and 61-67 have been cancelled.
3. Amendments to the claims, filed on September 5, 2007, have been entered in the above-identified application.

Election/Restrictions

4. Applicant's election with traverse of species I in the reply filed on November 19, 2007 is acknowledged. The traversal is on the ground(s) that search of the classes would be the same for both species. This is not found persuasive because the species are not capable of use together and have materially different design.

The requirement is still deemed proper and is therefore made FINAL.

5. Claims 53 and 55 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on November 19, 2007.

WITHDRAWN REJECTIONS

6. The 35 U.S.C. §102 and §103 rejections made of record in the office action mailed June 29, 2007, pages 2-5, paragraphs #4-#7 has been withdrawn due to Applicant's amendment in the response filed September 5, 2007.

REJECTIONS

7. **The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.**

Claim Objections

8. Claim 8 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 8 states that the article comprises a non-structured exposed surface, which is not further limiting since claim 1 already recites that the non-touching surfaces of the backing and the adhesive are non-structured.

Claim Rejections - 35 USC § 112

9. Claims 1, 3-8, 10-17, 19-21, 28-35 and 56-60 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites “an adhesive layer with a first major surface and a second major surface, wherein at least one of the first and second major surfaces is a structured surface” and further recites “the article has a non-structured exposed adhesive surface that can be adhered to a target substrate.” This is a broad limitation, e.g. 1 or 2 surfaces are structured, followed by a narrower limitation, e.g. only 1 surface is structured. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by “such as” and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949).

Claim 21 recites “the second major surface is a structured surface” which renders the claim vague and indefinite. From claim 1 if the adhesive must have a non-structured exposed adhesive and a structured surface that contacts the backing, it is unclear how the adhesive can have a third structured surface not contacting the backing.

Claim Rejections - 35 USC § 102

10. Claims 1, 3, 4, 7, 8, 11-14, 16, 19 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Mann (U.S. Patent No. 2,638,430).

Regarding Applicant's claim 1, Mann discloses an article (*surface covering, title*) comprising an adhesive layer (*col. 5, line 51*) with a first major surface and a second major surface (*figures 2 and 3*), wherein at least one of the first and second major surfaces is a structured surface (*col. 5, lines 74-75*); and a backing (*col. 5, lines 53-55*) directly adjacent to the structured surface(s) of the adhesive layer (*figure 3*), wherein the both surfaces of the backing are non-structured (*figure 3*). The article comprises discrete reservoirs (*col. 5, lines 74-75*) between the structured surface of the adhesive layer and the backing (*figures 2 and 3*). The article has a non-structured exposed adhesive surface that can be adhered to a target substrate, since the non-structured side of the adhesive has a release paper on it that permits removal during installation (*col. 5, lines 45-50*).

Regarding Applicant's claims 3 and 4, Mann discloses that the adhesive layer is a pressure sensitive adhesive is selected from the group consisting of acrylics, natural and synthetic rubbers, ethylene vinyl acetate, vinyl ethers, silicones, poly(alpha olefins), and combinations thereof (*col. 2, lines 1-2 and col. 5, lines 30-40*).

Regarding Applicant's claim 7, Mann discloses at least one non-adhesive layer in contact with one of the first and second major surfaces (*col. 5, lines 45-50 and figures 2 and 3*).

Regarding Applicant's claim 8, Mann discloses the article comprises a non-structured exposed surface (*figures 2 and 3*).

Regarding Applicant's claim 11, Mann disclose the article comprises a plurality of channels (*col. 5, lines 45-50*).

Regarding Applicant's claims 12-14 and 16, Mann discloses that reservoirs/channels contain at least one deliverable or non-deliverable vibration-damping fluid substance (*air, figures 2 and 3*).

Regarding Applicant's claim 19, Mann discloses the backing is a laminate (*title*).

Regarding Applicant's claim 20, Mann discloses the second major surface is a non-structures surface, the backing contacts the first major surface, and wherein the article further comprises a backing layer on the second major surface (*col. 5, lines 45-50*).

Claim Rejections - 35 USC § 103

11. Claims 5, 10, 22, 26 and 56-60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mann (U.S. Patent No. 2,638,430).

Mann is relied upon as described above.

Mann fails to disclose the peel strength, the thickness of the tape or the volume of the voids/reservoir/channels.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the peel strength, the thickness of the tape or the volume of the voids/reservoir/channels to the claimed ranges, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art in absence of showing unexpected results. MPEP 2144.05 (II).

ANSWERS TO APPLICANT'S ARGUMENTS

12. Applicant's arguments in the response filed September 5, 2007 regarding the previous rejections of record have been considered but are moot since the rejections have been withdrawn.

Conclusion

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (571) 272-1490. The examiner can normally be reached on Monday through Friday from 8:00 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye, can be reached on (571) 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ac
1/1/08


ALICIA CHEVALIER
PRIMARY EXAMINER